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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CHOI, PETER H	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/899,526	MORRISON, ROYCE	
	Examiner	Art Unit	
	Peter Choi	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *7/6/01* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/29/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 are pending in the application.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- In Figure 2, **clock 245**, **cryptographic processor 260** and **communications port 265** are not mentioned in the specification. However, similar items are cited in the description of Figure 3.
- In Figure 3, **application software 355** is not mentioned in the specification. However, similar items are cited in the description of Figure 2.
- In Figure 3, reference character 350 is used in conjunction with **Decision Influencer Communication Support**. However, reference character 350 is used on page 48 of the specification to define an operating system.
- In Figure 4, reference character 426 is used in conjunction with **Participating Decision Influencers Database**. However, on page 44 of the specification, reference character 425 is used.

- In Figure 4, reference character 428 is used on conjunction with CDPI Process Reference Database. Although the specification discloses that 428 is indeed a database, it never describes the specific database that 428 refers to.
- In Figure 5, reference characters 550, 560, and 565 are used in conjunction with various process steps. However, these steps are not described in the specification in conjunction with the reference characters used.
- In Figure 7, reference character 758 is used in conjunction with a prompting step. However, this step is not described in the specification in conjunction with the reference character used.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-6 only recite an abstract idea. The recited method for marketing a health care product does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed by use of a pencil and paper. The claimed invention, as a whole, is not within the technological arts as explained above, and claims 1-6 are deemed to be directed to non-statutory subject matter.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In the present case, none of the recited steps in claims 1-6 are directed to anything in the technological arts as explained above, with the exception of the step of retrieving information from a database accessible by a computer system.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention receives and analyzes information (i.e., repeatable) used in determining and selecting the best action to take (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-6 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Brinkman et al. (U.S Patent #6,697,783).

As per claim 1, Brinkman et al. teaches a method employing a computer system for marketing a health care product, the method comprising:

receiving information about characteristics of at least one of a consumer **(member profile 709, including areas that list the member's health benefit plan information, prescription drug history, self-reported health information, recent contact history, allergies 1501, prescriptions 1502, and pre-existing heath conditions 1503)** and a decision influencer [Column 10, lines 22-29, Claim 1a];

based on the received information, retrieving stored information **(clinical information 710)** from a database accessible by the computer system, the stored information containing at least one of consumer information **(recommended forms of treatment and courses of action)**, decision influencer information **(health benefit information 712 such as insurance company rules, member information and benefit plan resources)**, and product information **(recommended forms of medications, pharmaceutical information 711 such as prescription drug side**

effects and complications that may be associated with particular drugs or combinations of drugs) [Column 10, lines 30-47, Claim 1b, 1c, 1d];

analyzing the received information and the stored information to determine presence of a sufficient indication of:

(i) consumer interest in the health care product **(request for a new prescription, prescription refill or prescription renewal; members who have called with inquiries about symptoms that can be treated by a new drug or treatment)** [Claim 4, Column 11, lines 20-24, and Column 12, lines 45-47];

if sufficient indication is present, retrieving a list of potential actions **(direct caller to an audiotext application 1110, select documents 1116 for the caller, update member profile 1120 based on the inquiry made and advice given during the call, determine that a referral is necessary 1115)** related to the health care product from a product information database [Column 15, lines 10-49];

evaluating whether to perform each of the potential actions **(determine an appropriate course of action for the caller)** based on at least one of the consumer information **(member profile database 1121)**, the decision influencer information **(clinical information database 1111, pharmaceutical information database 1112, and health benefit information database 113)**, the product information, and action-specific criteria [Column 14, line 62 – Column 15, line 1]; and

performing potential actions **(provide analysis and advice 708, transfer the caller to an appropriate operator in response to the caller's inquiry, generate a referral 1117 so that the caller may visit a participating provider; generate alerts**

and messages for the operator to provide to the caller relating to items such as appropriate prescription drug use, medications the caller should avoid or use in moderation or speak to a physician before using, suggested forms of treatment based on the caller's symptoms, prescription refill reminders, prescription renewal reminders, and other information; package information collected during the call, combined with specific pharmacy information, for delivery to the caller's physician, health plan, or other health care provider) that meet action-specific criteria [Column 10, lines 18-20, and Column 15, lines 10-49].

As per claim 7, Brinkman et al. teaches a computer system to facilitate marketing of a health care product, comprising:

an interface device **(telephone voice line and computer 501)** for receiving information about characteristics of at least one of a consumer and a decision influencer [Column 8, lines 12-16]; and

a system controller **(operator)** having access to a first data medium **(database)** that stores data about a plurality of decision influencers and a second data medium **(database)** that stores data about the health care product, wherein, based on the characteristics information and the stored data, the system controller identifies decision influencers ***(pharmaceutical companies)*** that have a product-related relationship with the consumer ***{drugs or treatments prescribed to the user}*** and communicates information to the identified decision influencers **(members who have called with inquiries about symptoms that may be treated by new drugs or treatments**

developed by the pharmaceutical company) about at least one of the health care product, consumer interest in the health care product, presence of the product-related relationship with the consumer, and a request by the consumer that the information be communicated [Column 12, lines 45-47].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkman et al. (U.S Patent #6,697,783).

As per claims 2-4, Brinkman et al. fails to explicitly teach the steps of prioritizing, sequencing, and grouping potential actions that meet action-specific criteria. However, Brinkman et al. teaches the method according to claim 1, further comprising, prior to the performing step, the step of selecting a guideline relating to the caller's condition that prompts the operator to ask the caller a series of questions 1602 relating to the caller's condition, and then provide the operator with a disposition 1604 or suggested course of action to provide to the caller [Column 10, lines 50-56. Figure 16].

Official Notice is taken that it is a common practice in the medical art that, in order to treat a medical condition, a description of the symptoms must be obtained in order to diagnosis and treat said medical condition. A series of actions are performed in a sequential (and prioritized) order (obtaining background medical history, obtaining vital health information {heart rate, pulse, etc.}, examination by a doctor, diagnosis, prescription of treatment, etc.) in the execution of this practice.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the questions taught by Brinkman et al. to sequentially structure the questions (provided by the guideline) in a manner {i.e., if caller answers "YES" to question X, then go to question Y, otherwise go to question Z, etc.} that groups questions directed to information of similar nature {i.e., obtaining information on symptoms, medical history, etc.} together in order to collect pertinent information required in the process of effectively and efficiently diagnosing and treating the symptoms (effectively prioritizing the information obtained from the caller).

As per claim 5, Brinkman et al. teaches a computer-implemented method for facilitating marketing of a health care product, the method comprising:
receiving input from at least one of a consumer and a system agent that identifies consumer interest in the health care product and that contains consumer identity information **(member profile 709, including areas that list the member's health**

benefit plan information, prescription drug history, self-reported health information, recent contact history, allergies 1501, prescriptions 1502, and pre-existing heath conditions 1503) [Column 10, lines 22-29];

absent explicit information from the consumer, communicating information about consumer interest **(request for a new prescription, prescription refill or prescription renewal; members who have called with inquiries about systems that may be benefited by new drugs or treatments developed by a pharmaceutical company)** to the identified decision influencer {pharmaceutical company} **[Column 12, lines 45-47]**

Although Brinkman et al. does not explicitly teach the step of identifying a decision influencer that has a product-related relationship with the consumer, the member profile taught by Brinkman et al. includes a history of prescription drugs that enables identification of the pharmaceutical companies associated with said drugs. The association of the consumer and their relationship with a pharmaceutical company would also obtain the additional benefits of enabling the demographic profiling of users of the prescription drugs and treatments offered by the pharmaceutical company, and providing reports of consumer usage of (or interest in) products associated with particular pharmaceutical companies to health care providers for consideration for inclusion in coverage plans. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Brinkman et al. to include the step of identifying the decision influencer to obtain the benefits discussed above therein.

As per claim 6, Brinkman et al. teaches the method according to claim 5, wherein the identifying step is accomplished by identifying the decision influencer ***{pharmaceutical company associated with prescription and over-the-counter medications that will help alleviate particular symptoms}*** from a plurality of decision influencers stored in a database **(pharmaceutical information database 1112)** [Column 15, lines 5-9].

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Iliff (U.S Patent #5,660,176) teaches a computerized medical diagnostic and treatment advice system.

Altschuler et al. (U.S Patent #6,151,585) teaches a method and apparatus for determining or inferring influential rumormongers from resource usage data.

Summerell et al. (U.S Patent #5,937,387) teaches a system and method for developing and selecting a customized wellness plan.

Szabo (U.S Patent #5,954,640) teaches a method for proposing and providing the nutritional supplementation for a person comprising the steps of receiving personal information about the person, determining a health model for the person, and optimizing a proposed nutritional supplementation for the person.

Brill et al. (U.S Patent #5,299,121) teaches a non-prescription drug medication screening system.

Lloyd (U.S Patent #5,181,743) teaches a drug information request system.

Walker et al. (U.S Patent #5,862,223) teaches a method and apparatus for a commercial network system designed to facilitate and support expert-based commerce.

Tallman et al. (U.S Patent #5,964,700) teaches a medical network management article of manufacture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PC

July 21, 2005

Susanne Diaz

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PRIMARY EXAMINER
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